

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM DOUGLAS POYNTER

Appeal No. 2006-1542
Application No. 09/847,755

MAILED

JUN 27 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before KRASS, JERRY SMITH, and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-12, which constitute all of the claims pending in this application.

We reverse.

BACKGROUND

Appellant's invention is directed to display design tools for designing character sets having a dot matrix design. According to Appellant, the user is allowed to specify the matrix size and to create a design for each character in the character set, as well as specifying pixel values for each location in a matrix. An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

1. A dot matrix display design tool, comprising;

a font designer for creating a character set comprising a plurality of characters and a character design associated with each of the characters, the character design comprising a pattern of selected and deselected pixel positions in a matrix of pixel positions, the font designer creating each character design in response to selections made by a user, the font designer further allowing the user to save and delete character as desired; and

a display designer comprising a text input entry interface for text input by a user and a character set selection interface to allow user selection of a selected character set for displaying the text, the display designer further comprising an operating characteristics interface for receiving operating characteristics entries specifying operating characteristics of an operating display to be emulated, the display designer further including a display emulator presenting a representation of the operating display, the representation of the operating display presenting the text input in a format reflecting the selected character set and exhibiting the operating characteristics specified by the operating characteristics entries, the display designer further including a set of editing tools to allow modification of the display in

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operating characteristics of the display, modifications made using the editing tools being reflected in the appearance of the text as presented by the display emulator.

The Examiner relies on the following references:

Dowling et al. (Dowling) 5,995,086 Nov. 30, 1999

NEC Corporation (NEC), "Character Pattern Editor for On-Screen Display of LSI for Windows," November 2000.

Claims 1-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dowling and NEC.

Rather than reiterate the opposing arguments, reference is made to the briefs and the answer for the respective positions of Appellant and the Examiner. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the briefs have not been considered (37 CFR § 41.37(c)(1)(vii)).

OPINION

In rejecting the claims, the Examiner relies on Dowling for teaching substantially all of the claimed method steps related to displaying predefined characters contained in a font and on NEC for disclosing a character pattern editor for on-screen display for windows (answer, pages 3-4). Based on the teachings of these two prior art references, the Examiner concludes that the skilled artisan would have found it obvious to modify Dowling with the display of NEC (page 11, 3rd paragraph) to provide superior user

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display of NEC (page 11, 3rd paragraph) to provide superior user interfacing and ease of editing large volumes of data (answer, page 4).

Appellant points out that different fonts in Dowling are created by varying font variables such as width, weight, size, and style in different ways depending on whether the characters' font variable exceeds a threshold value (brief, pages 6-7). Appellant asserts that such way of processing are unrelated to the problem of evaluating the appearance of dot matrix designs, as recited in the claims (brief, page 7). Thus, Appellant argues that the claimed subject matter is absent in the teachings of the prior art as Dowling merely addresses modifying a characteristic of a character based on how its value exceeds a threshold value and NEC relates to a character pattern editor for creating an entire character set (brief, page 9). With respect to Dowling, Appellant argues that the reference discloses no editing tools while NEC is concerned with only developing a character pattern by editing a character on a pixel basis and not the claimed appearance of a text as presented by the display emulator (brief, page 10).

In response to Appellant's arguments, the Examiner asserts that NEC does emulate a display since "emulation" is merely "imitation" and the display in NEC will imitate the selected

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34 of NEC for teaching the user's ability to manipulate a plurality of pixels by size and shape (id.).

As a general proposition, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149

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F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Such evidence is required in order to establish a prima facie case.

In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

After reviewing Dowling, we agree with Appellant (reply brief, page 3) that different changes made to the fonts according to their ranges of weight values, as described in Dowling, concerns modifying the characteristics of a character based on whether the value exceeds a threshold value, and not those represented in an operating display, as recited in the instant claims. NEC, on the other hand, provides a design tool for character pattern creation and storage of the entire character set (Figure 3-3 and section 3.2.2).

Therefore, what the Examiner characterizes as the claimed design tool in Dowling, actually relates to the design of a character set which presents no connection with the claimed operating characteristics interface for receiving operating characteristics entries specifying operating characteristics of an operating display to be emulated. This particular display is what Appellant is considering for a particular design application (reply brief, page 3). As such Dowling merely addresses modifications to a character set according to how they compare

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with a threshold value while NEC includes nothing related to an operating display. Even assuming, arguendo, that it would have been obvious to combine Dowling with NEC, the Examiner has not shown how the recited features may be derived from changing the characteristics of a character set. A rejection based on section 103 must rest upon a factual basis rather than conjecture, or speculation. "Where the legal conclusion [of obviousness] is not supported by the facts it cannot stand." In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). See also In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) and In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). Accordingly, as the Examiner has failed to set forth a prima facie case of obviousness, we cannot sustain the 35 U.S.C. § 103 rejection of claims 1-12 over Dowling and NEC. However, our decision not to sustain the instant rejection should not be construed as an indication that the claims are patentable or better prior art may not be applied alone or in combination with other art.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-12 under 35 U.S.C. § 103 is reversed.

REVERSED


ERROL A. KRASS)
Administrative Patent Judge)
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JERRY SMITH) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES

MAHSHID D. SAADAT)
Administrative Patent Judge)

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